



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,767	03/30/2000	Yvonne Ng	1697 (USW 0562 PUS)	8838

22193 7590 12/16/2002

QWEST COMMUNICATIONS INTERNATIONAL INC
LAW DEPT INTELLECTUAL PROPERTY GROUP
1801 CALIFORNIA STREET, SUITE 3800
DENVER, CO 80202

EXAMINER

LEE, SEUNG H

ART UNIT PAPER NUMBER

2876

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,767

Applicant(s)

NG, YVONNE

Examiner

Seung H Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the amended appeal brief filed on 3 October 2002, which has been entered in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 11-19, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser et al (US 5,982,520, of the record)(hereinafter referred to as 'Weiser') in view of Teicher (US 5,744,787, of the record).

Weiser teaches that a personal storage device (30) in which serves as a smart card comprising a microprocessor (40) and a memory (42) storing information (e.g., name, address, telephone numbers, email address, personal or corporate web site identifier, etc.) in which serves as a master list, and synchronizing information with remote appliances such as a personnel computer (12) in which is connected to a local area network (18), a computer workstation (24) in which is connected to a wide area network (19), an automation control system (20) and a security authorization unit (21) in which are non-web enabled system, a personal digital assistance (22), and a notebook computer (23) through the wireless communication means (110, 112, 114, 116, 122, 124, 126, 128, 130, 132, 134, and 136) using transceivers (140, 142, 144, 146, 148,

Art Unit: 2876

and 150) in which provide functions of a card reader to access the information stored in the personal storage device, and the remote appliances includes displays to display information thereon, the memory contains applications or programs executable using the processor (40) to send/receive information from other systems using wireless communication (see Figs. 1-3; col. 2, lines 3-40; col. 4, line 13- col. 6, line 45).

However, Weiser fails to particularly teach that the personnel storage unit is smart card and the microprocessor is programmed to send information to the remote appliances to display thereon and the memory includes an electronic wallet.

Teicher discloses that the payment unit (8) includes a display to display the status of information during the transaction, and an electronic wallet (9) in which serves as the smart card (see Figs. 2 and 4; col. 1, line 21 – 57; col. 9, line 46-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the conventional electronic wallet as taught by Teicher to the teachings of Weiser in order to provide a easier and quicker transaction of purchase at the point of sale (POS) terminal, gas station, or the like. First of all, such modification would provide a constant acknowledgement of the value of electronic wallet every time the electronic funds are consumed by the customers (i.e., unlike the conventional/typical credit card which the customers have to wait until the monthly billing statement or to call the customer service center to verify the past transaction. Second, such modification would provide the easier replenishing the value of the electronic wallet by authorizing cash/money transfer from the bank account (i.e., the checking account, the credit card) to the smart card using ATM, telephone, Internet

Art Unit: 2876

transaction, or the like, then the value of electronic wallet on the smart card will be replenished during the next authorization process. Third, such modification would provide an improved and an enhanced means operator(s) can obtain the transaction/transmission information constantly from display in which display the status information during the process. Finally, such modification would provide a convenient means wherein customer(s) can carry the electronic wallet within his/her wallet/purse without carrying particular storage unit, and therefore an obvious expedient.

4. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser as modified by Teicher as discussed in claims 1 and 11 above, and further in view of Taylor (US 5,578,808, on the record).

The teachings of Weiser/Teicher have been discussed above.

Although, Weiser/Teicher teaches the smart card system, Weiser/Teicher fails to teach or fairly suggest that at least one of the pluralities of entries is a password

Taylor teaches the password (PIN) (see Fig. 1; col. 3, line 21 – 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known password as taught by Taylor to the teachings of Weiser/Teicher in order to provide a secure process of the accessing each application on the smart card by assigning each application with its own unique password. Also, such modification (assigning the password with its own application) would prevent accidental processing of a particular application, since each application password can be different from other application's password and only the

application with correct assigned password can authorize the processing, and therefore an obvious expedient

5. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser as modified by Teicher as discussed in claims 1 and 11 above, and further in view of Chen et al. (US 5,694,471, on the record)(hereinafter referred to as 'Chen').

The teachings of Weiser/Teicher have been discussed above.

Although, Weiser/Teicher teaches a smart card system, Weiser/Teicher fails to teach or fairly suggest that the smart card having encrypted password to control access the master list.

Chen teaches the using encrypted password to access the application onto the smart card to access the application onto the smart card (420 – 450)(see Fig. 5; col. 2, line 9 – 39; col. 10, line 14 – 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the well known encrypted password as taught by Chen to the teachings of the Weiser/Teicher in order to provide an improve authentication process to access the master list within the smart card. Also, such modification would provide a secure synchronizing process by having the conventionally known encrypted password assigned to the smart card to be verified by the remote appliance to synchronize between the local list in the remote appliance and the master list on the smart card, therefore and an obvious expedient.

Response to Arguments

Applicant's amended appeal brief with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that "*Weiser does not anticipate claim 1 because the personal storage device of Weiser does not include the claimed feature of a compact user-carried card.....does not take the physical form of a smart card.*" (see page 3, line 4+), Teicher references teaches the electronic wallet wherein the electronic wallet serves as a smart card as discussed in paragraph 3 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Ronnback [WO 90/00782] discloses an electronic memory storing information to check credit cards.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Seung H. Lee
Art Unit 2876
December 12, 2002

SHL


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800